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IN THE

Supreme Court of the United States

OCTOBER TERM 1940.

No. 398

THE HAMILTON LABORATORIES, INC,
Petitioner,

vs.

SAMUEL E. MASSENGILL, DOING BUSINESS AS
THE S. E. MASSENGILL COMPANY,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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September, 1940.

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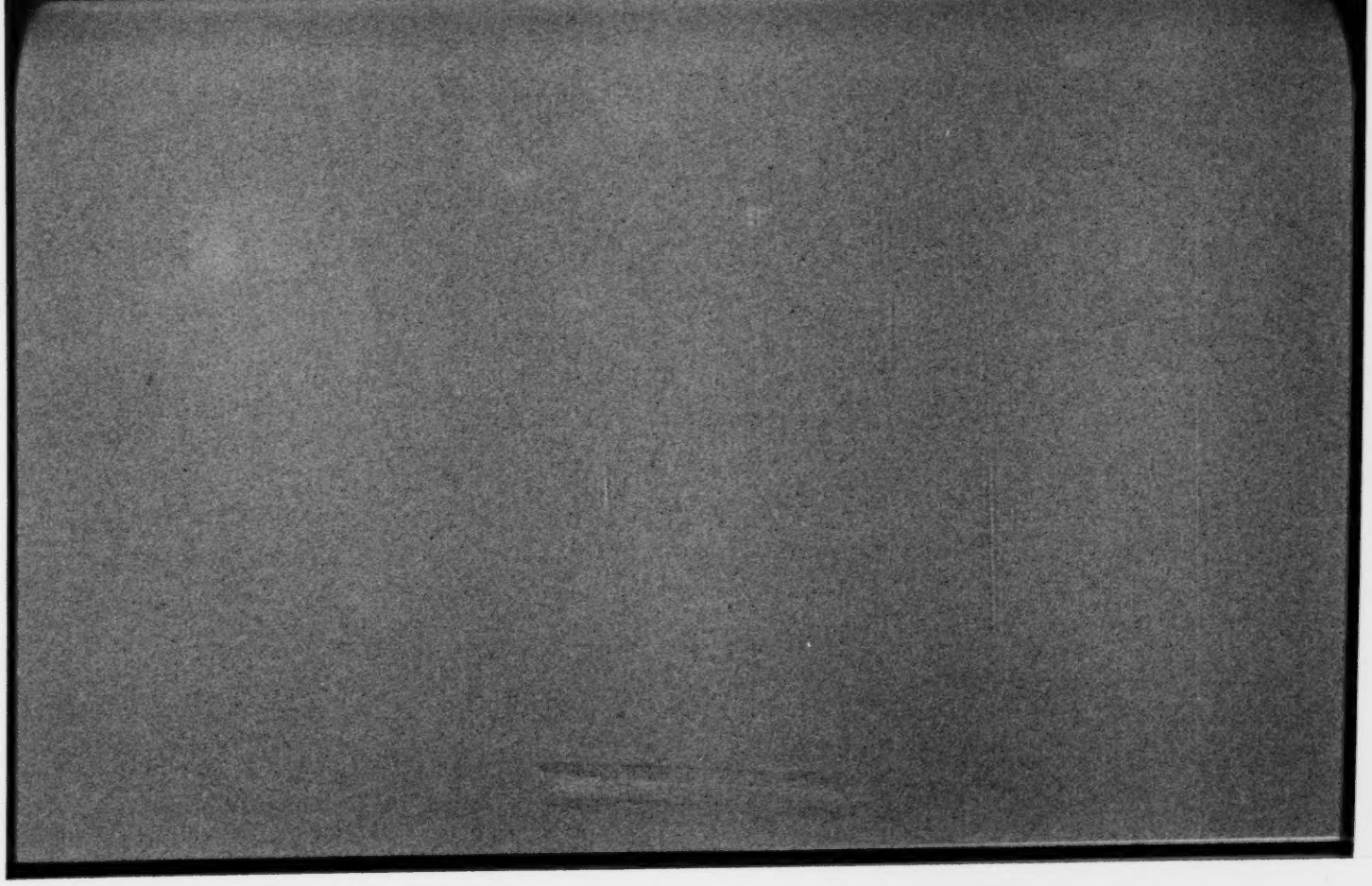

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BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

This is a suit for infringement of petitioner's patent to Weed, No. 2,014,676 (R. 251; offered R. 16) based on a continuation of an application filed July 29, 1932 (Stipulation, R. 255). The patent was held invalid both by the District Court (Record, pp. 229-236 and 25 F. Supp. 464), and by the Circuit Court of Appeals for the Sixth Circuit (R. 723-730 and 111 F. [2d] 584). No court has ever held the patent valid, and no conflict of decisions upon the issues of this case is presented.

The patent claims the therapeutic use as bactericides or fungicides of any one of a group of organic mercurials; the group admittedly (R. 54-56) including hundreds of

thousands of aryl mercuric compounds. The patent does not claim to have invented these compounds—they were old. It is undisputed that the particular methods by which the patentee diluted and applied the compounds did not differ from the methods by which mercuric germicides generally are administered. Thus invention was asserted only in allegedly discovering the therapeutic utility of mercurials of this vast group.

The petition at page 4 asserts that four numbered questions are here presented. Of these, only the first numbered question was actually decided by the Circuit Court of Appeals below, and that question was not regarded by that Court as determinative of the holding of invalidity herein. The alleged questions 2, 3 and 4 do not correspond to the holdings actually made by the Court and are not properly present here.

Question 1 asks whether a typewritten thesis filed in a college library (in 1928) is a "printed publication." This thesis (R. 413-442; offered R. 96) was not the "determinative" ground on which the Circuit Court of Appeals held the patent invalid. The District Court likewise had held the patent invalid, even though it had ruled that this thesis was not a printed publication (Finding 23, R. 241). The ruling on the point by the Circuit Court of Appeals (R. 723-724) states:

> "While perhaps not determinative of ultimate issues in the present case, the Weed thesis is in the prior art and marks a step in its development since it was put on file in the library of the college, available to students there and to other libraries having exchange arrangements with Iowa State."

The petition does not allege that this reasonable ruling is contrary to any decision of this Court or of the lower courts, and it is believed too unimportant as here presented to justify grant of the petition. Obviously, when,

as here, a student "publishes" a thesis, a patent application thereon filed by him more than two years later should be barred by R. S. 4886, 35 U. S. C. 31.

Question 2, said to be presented, is not actually in issue. The Circuit Court of Appeals did not in fact hold that a patent is necessarily invalid if drawn to cover a range of equivalents beyond the specific compounds actually used. It merely held (at R. 729) that the same test must be applied to the Weed patent in suit as to the 1924 White prior art publication (R. 625; offered R. 197). Both White (R. 726-727) and Weed recite specific examples and suggest a large class of compounds. The Court overruled appellant's contention that White had merely made a prophecy in recommending thousands of organic mercurials, since the patentee Weed would be subject to the same criticism in likewise covering thousands of the same organic mercurials without ever having tried more than twenty (R. 56). There is admittedly no contrary decision by this Court, and there is actually no conflict with the Patent Office and District of Columbia decisions cited.

Moreover, claims of the patent in suit did not in fact define a group having common properties which differ in more than degree from those admittedly outside the claims. The claims call for organic mercurials which ionize in water to place the mercury atom in the positively charged ion or cation leaving the balance of the compound in the negatively charged ion or anion (R. 251, first column, lines 13-16; offered R. 16). But organic mercurials have long been known as germicides and are admittedly effective, in which the substance ionizes in water to place the mercury atom in the negatively charged ion (R. 67 and 215). The theory on which the patent depends for claiming that the method of ionization is important, was admitted by petitioner's witnesses to be still a mere theory (R. 67) and not "a thing that you could say definitely yet

that that was true" (R. 29). Even if a difference in degree appears between the organic mercurials within and without the claims, the same thing is true of the organic mercurials which are wholly within the claims—they also differ in degree of effectiveness (R. 56). Petitioner's own advertising booklet (R. 370) points out some of these differences at pages 10, 13 and 16, and declines at page 21 even at the time of trial to recommend the patented compounds for internal use either intravenously or orally (see also R. 62). Thus, the group claimed is not "well defined" as petitioner asserts, and the claims might have been (but were not) held invalid on this ground without any conflict with the cases cited at pages 11 and 12 of petitioner's brief.

Question 3 is misleading. It appears to present to this Court the question of whether patentable invention may ever arise in chemical research—a possibility not disputed by the opinion of the Court of Appeals. The true question (R. 728) was whether patentable invention could result from merely determining, by obvious and easy laboratory testing, a utility which had been already described for this entire field by the prior White publication. There is nothing in this holding in conflict with the cited case of *Corona Co.* v. *Dovan Corporation*, 276 U. S. 358, 368-9, where the prior art (other than Kratz) had limited its teachings to T. P. G. and had not included reference to D. P. G. as an accelerator.

Question 4 is likewise misleading and not actually presented. The Court of Appeals did not hold that the patentee was "estopped to contest the pertinence" of the prior Kharasch patent 1,770,886. The Court pointed out (R. 730) that Weed had already, in the Weed and Ecker article of 1931 (R. 459 and 463; offered R. 114) and former application (R. 538, 539 and 541; offered R. 86), treated the disinfectant use of these organic mercurials for plants and seeds as analogous to their germicidal use for

animals or human beings, and had abandoned this earlier application when it had been rejected on the Kharasch patent (R. 581, lines 23-34; offered R. 197) which taught use of these mercurials for plants and seeds and mentioned that they were innocuous to the hands of the human user. Such conduct by patentee, before filing his application for the patent in suit, was an admission by him adding force to the showing that the two arts were analogous, but it was not held to estop petitioner from contesting the pertinence of the Kharasch patent. Nothing in the opinion is therefore in conflict with the cited case of *Smith* v. *Snow*, 294 U. S. 1, 16. It is believed further, however, that the permanent abandonment of an application following a citation, as occurred in the present case (R. 538), is a much plainer acquiescence than the cancellation of a narrow claim and the substitution of a broader one in the same application as occurred in *Smith* v. *Snow*.

Conclusion

The petition appears lacking in any of the ordinary grounds set forth in Rule 38, paragraph 5 of the Rules of this Court, for the issuance of a writ of certiorari, and the attempted showing of novel or unsound grounds for the decision below appears without substance.

Respectfully submitted,

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September, 1940.

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